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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,720	09/30/2004	Fred Bishop	03292.101090.28	5719
66569 7590 12/09/2008 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER COPPOLA, JACOB C				
ART UNIT 3621		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/711,720

Applicant(s)

BISHOP ET AL.

Examiner

JACOB C. COPPOLA

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5, 6 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 6 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 23 October 2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 C.F.R. § 1.114

1. A request for continued examination under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicants' submission filed on 23 October 2008 has been entered.

Acknowledgements

2. This action is in reply to the Remarks and Amendments filed on 23 October 2008.
3. Claims 1, 3, 5, 6, and 9-11 are currently pending and have been examined.
4. This Office Action is given Paper No. 20081201. This Paper No. is for reference purposes only.

Information Disclosure Statement

5. The Information Disclosure Statement filed on 23 October 2008 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 9 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

8. Regarding claim 9:

a. As recited, this claim is directed toward “a computer-readable storage medium containing a set of instructions for a general purpose computer”. However, under the current guidelines of 35 USC 101, instructions for a general purpose computer must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the instructions. In the broadest reasonable interpretation and in light of the specification, claim 9, as recited, can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection. Accordingly, claim 9 is not eligible for patent protection.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3, 5, 6, 9-11, as understood by the Examiner, are rejected under 35 U.S.C.

§103(a) as being unpatentable over Taylor (U.S. 5,578,808 A) (“Taylor”), in view of Russell et al. (U.S. 2004/0044627 A1) (“Russell”).

11. Regarding claim 1:

b. Taylor discloses the following limitations:

i. *adding to a database on a transaction device a first data set of a first format and a second data set of a second format (figs. 1 and 4 with associated text), wherein:*

(1) *the first data set is owned by a first data set owner and the second data set is owned by a second data set owner (figs. 1 and 4 with associated text);*

(2) *the first data set owner is distinct from the second data set owner (figs. 1 and 4 with associated text);*

(3) *the first format is different from the second format (figs. 1 and 4 with associated text); and*

(4) *the first data set is stored in accordance with the first format, and the second data set is stored in accordance with the second format (figs. 1 and 4 with associated text);*

ii. *configuring a first secondary identifier correlated to the first data set and a second secondary identifier correlated to the second data set, wherein the first secondary identifier and the second secondary identifier are configured by the first*

data set owner and the second data set owner independently (figs. 1 and 4 with associated text);

iii. *receiving a selection of at least one of the first data set and the second data set to complete a transaction request (fig. 6a with associated text), wherein:*

(5) *if the first data set is selected, the receiving includes receiving a first secondary identifier indicia (fig. 7 with associated text); and*

(6) *if the second data set is selected, the receiving includes receiving a second secondary identifier indicia (fig. 7 with associated text);*

iv. *authenticating the transaction request using the first secondary identifier indicia if the first data set is selected and using the second secondary identifier indicia if the second data set is selected (fig. 7 with associated text);*

v. *determining, based on the authenticating, whether the transaction request is approved (fig. 7 with associated text); and*

vi. *completing, if the determining indicates that the transaction request is approved, the transaction request according to the selection (fig. 7 with associated text).*

c. Taylor does not directly disclose the following limitations:

vii. *an RF transaction device.*

d. Russell, however, teaches the limitations:

viii. *an RF transaction device (¶ 0170).*

e. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the

prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the RF transaction device of Russell for the transaction device of Taylor. Thus, the simple substitution of one known element for another, producing predictable results, renders the claim obvious.

12. Regarding claim 9:

f. This claim is understood by the Examiner to be of substantially the same scope as claim 1. Accordingly, claim 9 is rejected in substantially the same manner as claim 1. If in response to this action the Applicant disagrees that the claims are of substantially the same scope, and provides evidence that they are of different scope, the Examiner may withdraw this rejection under §103 and alternatively impose a restriction requirement.

13. Regarding claims 3, 5, 6, 11, and 12, Taylor/Russell discloses the limitations of claims 1 and 9, as described above. Taylor/Russell, further, discloses the following limitations:

g. Claim 3: *The method of claim 1, wherein at least one of the first secondary identifier indicia and the second secondary identifier indicia is a personal identifier number (PIN) or a biometric identifier (Taylor, fig. 7 with associated text);*

h. Claim 5: *The method of claim 1, wherein the step of receiving a selection further comprises receiving an allocation of a first portion of the transaction request to the first data set for transaction completion (Russell, ¶ 0037);*

i. Claim 6: *The method of claim 5, wherein the step of receiving a selection further comprises receiving an allocation of a second portion of the transaction request to the second data set for transaction completion (Russell, ¶ 0037);*

- j. Claim 10: *The method of claim 1, wherein the receiving a selection step further comprises receiving an allocation of the entire transaction request to either the first data set or the second data set (Taylor, fig. 7 with associated text); and*
- k. Claim 11: *The method of claim 1, wherein the receiving a selection step further comprises receiving a selection of a plurality of data sets to complete the transaction request (Russell, ¶ 0037).*
14. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Response to Arguments

15. Applicants' arguments with respect to claims 1, 3, 5, 6, and 9-11 have been considered but are moot in view of the new grounds of rejection.

Conclusion

16. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet

Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see *e.g.* "User Level Beginning..."), because of the references' basic content (which is self-evident upon examination of the references), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these references.

17. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C. Coppola/

Patent Examiner, Art Unit 3621

December 1, 2008

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621